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10/779,421	02/13/2004	Robert H. Wollenberg	T-6320 (538-66)	9070

7590 03/10/2008  
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EXAMINER
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GROSS, CHRISTOPHER M

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1639

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03/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**ADVISORY ACTION**

Continuation of 5

***Withdrawn Rejection***

The rejection of claims 33-35 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement are hereby withdrawn in view of applicant's persuasive arguments.

Continuation of 11

***Maintained Claim Rejections***

Claims 1-3,5-9,21 are rejected under 35 U.S.C. 102(b) as being anticipated by **Francisco et al** (US Patent 5,308,522).

Claims 1,2,4-5,8,10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Migdal et al** (US Patent 5,062,980).

Claims 1-3,5-9,21, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Chaffee et al** (US Patent 4,774,281).

***Response to Arguments***

Applicant argues not all elements are taught.

Applicant's arguments have been fully considered but they are not deemed persuasive for the following reasons.

Specifically, see p 7-8 (1/7/2008) Applicant argues that "high throughput" and "program control," despite appearing in the preamble, represents a limitation necessary to give life, meaning and vitality to the rejected claims. In particular, applicant draws and

analogy with high speed book manufacturing, citing On Demand Machine Corp. v. Ingram Industries Inc., 78 USPQ2d 1428, 1436-38 (Fed. Cir. 2006). (citing Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478 (CCPA 1951) where the court stated "The high speed manufacture of a single copy is fundamental to the Ross invention, for the specification highlights that the customer may **have a printed and bound copy within 'three to five minutes.'**" Col. 2, line 33. Emphasis added.

The examiner submits that On Demand Machine Corp. may be distinguished from the present case in that the specification provided a particular time (i.e. 3 to 5 minutes) to required to print a book, therein providing a necessary and defining aspect for the claimed method of high speed manufacture of a single copy of a book.

Quoting from the present specification, Applicant attempts make a similar argument, that the claimed high throughput method for screening lubricating oil compositions concerns "screening vast numbers of diverse compositions" and "large numbers of different lubricating oil compositions can be analyzed," however notably no indication as to the time to perform even one test is given, so as to adequately define an aspect of the claimed subject matter from the prior art according to Francisco or Migdal et al.

Claims 1-3,5-9,21 and 11-14,17-20 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Francisco et al** (US Patent 5,308,522) in view of **Kolosov et al** (US Patent Application 2004/0123650 – IDS entry 2/126/2006)

*Response to Arguments*

Applicant argues, see p 12-13 (1/7/2008) that there is no motivation to combine the teachings of Francisco et al with that of Kolosov et al because the robot based analysis system according to Kolosov et al requires flowable materials.

Here, Kolosov et al state in paragraph 0043, "In **one particular embodiment**, the present invention is employed for screening flowable materials" Emphasis added. In this regard, according to MPEP 2124, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). In paragraph 0044, Kolosov et al state further, "a polymer sample may be **heterogeneous**, and even further in paragraph 0048, that the polymer sample can, regardless of its particular form have various attributes including variations with respect to polarity, **solubility** and/or **miscibility**." Emphasis added. The examiner submits flowable materials represent a preferred embodiment for Kolosov et al. The examiner further submits elastomer samples are heterogeneous with variations with respect to solubility and miscibility, and thus compatible with the robot of Kolosov et al.

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,137,289 in view of

Francisco et al (US Patent 5,308,522) and further view of Bailey et al (US Patent 3,108,397)

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/528747 in view of Bailey et al (US Patent 3,108,397).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/699510 in view of Francisco et al (US Patent 5,308,522).

Claims 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of each of copending Application Nos. 11/605127, 10/699508, 10/699507, 10/779422 in view of Francisco et al (US Patent 5,308,522) and Guninther et al (US Patent Application 2004/0074452).

#### *Response to Arguments*

Applicant states that a suitable terminal disclaimer will be filed once the above issues are resolved.

Until such time that said terminal disclaimer(s) is(are) filed, the above double patenting rejections will be maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1639

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Christopher M Gross  
Examiner  
Art Unit 1639

cg

/Mark L. Shibuya, Ph.D./

Primary Examiner, Art Unit 1639